REMARKS

Favorable reconsideration of this application, in view of the present amendments and in light of the following discussion, is respectfully requested.

This amendment is submitted in accordance with 37 C.F.R. § 1.116, which after final rejection permits entering of amendments canceling claims, complying with any requirement of form expressly set forth in a previous Office Action, or presenting rejected claims in better form for consideration on appeal. The present amendment places the claims in condition for allowance, and does not raise new issues requiring further search and/or reconsideration. Therefore, it is respectfully requested that the present amendment be entered under 37 C.F.R. § 1.116.

Claims 1-8 and 31-46 are pending. Claims 1-8 are amended to clarify the features contained therein. No new matter is introduced.

In the outstanding Office Action, Claim 3 was rejected under 35 U.S.C. § 112, second paragraph; and Claims 1-8 and 31-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Narasimhan (U.S. Patent No. 6,073,165, hereafter "Narasimhan") in view of Moon (U.S. Patent No. 6,138,146, hereafter "Moon") and Pivowar (U.S. Patent No. 6,457,062, hereafter "Pivowar").

Initially, Claim 3 is amended to recite a method of forwarding email that includes, in part, *comparing start criteria stored on the server with start criteria stored on the client personal computer*. Therefore, it is submitted that amended Claim 3 is in conformity with the requirements of 35 U.S.C. § 112, second paragraph, and it is respectfully requested that the rejection of Claim 3 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In reply to the rejection of Claims 1-8 and 31-46 as being unpatentable over the combination of Narasimhan, Moon and Pivowar, Claim 1 is amended to recite, *inter alia*, a method of forwarding email that includes:

> examining start criteria, *the start criteria being*
> *independent of email stored in an email datastore...*
> comparing the start criteria stored on the client
> personal computer with start criteria stored on the server; and
> synchronizing the start criteria stored on the client
> personal computer and the start criteria stored on the server
> when a difference is detected therebetween. (Emphasis added.)

Turning to the applied references, Narasimhan describes a message processing and

forwarding system that receives messages over a computer communication network,

processes the messages, and forwards the messages to a receiver.[1] Moon describes a system

for retrieving e-mails stored on a private server (16) in a private network system (12) by a

remote communicator (30).[2] However, as acknowledged by the outstanding Office Action,

neither Narasimhan nor Moon describe synchronizing the start criteria stored on the client

personal computer and the start criteria stored on the server when a difference is detected

therebetween, as acknowledged by the outstanding Office Action.[3]

The outstanding Office Action, however, attempts to cure the above-noted deficiency

by combining Narasimhan and Moon with Pivowar. Pivowar describes a system (100) for

sharing data among a personal digital assistants (PDA's) (102) corresponding to a plurality of

users.[4] Pivowar describes that the personal data shared includes calendar information, such

as scheduled meetings and appointments, and contact information such as mailing addresses,

telephone numbers, facsimile numbers and electronic mail addresses.[5] Pivowar describes

that a name field, identification field and index field, which are used to determine the data to

be synchronized between the PDA (102) and server(104), are stored together with the

personal data.[6] More specifically, Pivowar describes that the name, identification and index

---

[1] Narasimhan at column 1, lines 39-43.
[2] Moon at column 5, lines 64-67; see also Figure 1.
[3] See the outstanding Office Action at page 3, item 8.
[4] Pivowar at column 4, lines 8-15; see also Figure 3.
[5] Pivowar at column 4, lines 25-34.
[6] Pivowar at column 5, line 53 - column 6, line 16; and Figure 3.

fields are synchronized with corresponding fields in the server (104), and that personal data corresponding to differences between these fields are marked for synchronization.[7] Then the marked personal data is synchronized.[8]

In rejecting Claims 1-8 and 31-46, the outstanding Office Action appears to identify the personal data of Pivowar as corresponding to the start criteria recited in amended Claim 1.[9] However, amended Claim 1 recites synchronizing the start criteria stored on the client personal computer and the start criteria stored on the server *when a difference is detected therebetween.* Conversely, Pivowar describes synchronizing the personal data when a difference is detected in the *name, identification and index fields* stored on the PDA (102) and the server (104), not when a difference is detected in the personal data itself. Thus, the personal data of Pivowar could not be the start criteria as recited in amended Claim 1.

Moreover, the claimed start criteria is independent of email stored in an email data store. However, the name, identification and index fields of Pivowar are stored together with other data to be synchronized (i.e. the personal data) and, as such, are not independent of the personal data. Therefore, the name, identification and index fields of Pivowar also could not be the claimed start criteria. Thus, Pivowar does not cure the above-noted deficiencies in Narasimhan and Moon and no combination of Narasimhan, Moon and Pivowar describes every feature recited in amended Claim 1. As such, it is submitted that amended Claim 1 is in condition for allowance, together with its corresponding dependent claims.

Further, Claims 2-8 recite features substantially similar to those recited in amended Claim 1, and are also in condition for allowance for substantially the same reasons, together with their corresponding depending claims. Accordingly, it is respectfully requested that the rejection of Claims 1-8 and 31-46 under 35 U.S.C. § 103(a) be withdrawn.

---

[7] Pivowar at column 7, lines 1 - 36.
[8] Id.
[9] See the outstanding Office Action at page 4, item 9.

For the reasons discussed above, no further issues are believed to be outstanding in

the present application, and the present application is believed to be in condition for formal

allowance. Therefore, a Notice of Allowance for Claims 1-8 and 31-46 is earnestly solicited.

Should, however, the above distinctions be found unpersuasive, Applicants

respectfully request that the Examiner provide an explanation via advisory action pursuant to

MPEP § 714.13 specifically rebutting the points raised herein for purposes of facilitating the

appeal process.

Respectfully submitted,

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/07)

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Scott A. McKeown
Attorney of Record
Registration No. 42,866

I:\ATTY\AMA\30's\305976US\305976US-AM.DOC

13